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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/652,899	08/31/2000	Fred Alan Bishop	10655.8000	3558

7590

10/15/2003

John G Bisbikis
McDermott Will & Emery
227 W Monroe Street
Chicago, IL 60606-5096

EXAMINER

WORJLOH, JALATEE

ART UNIT	PAPER NUMBER
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3621

DATE MAILED: 10/15/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/652,899

Applicant(s)

BISHOP ET AL.

Examiner

Jalatee Worjloh

Art Unit

3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on August 4, 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4 and 43-46 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4 and 43-46 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

1. This Office Action is responsive to the amendment filed on August 4, 2003, in which claims 1, 43 and 46 were amended.

Response to Arguments

1. Applicant's arguments with respect to claims 1-4 and 43-46 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-4 and 43-46 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6327578 to Linehan in view of US Patent No. 6560581 to Fox et al.

Referring to claims 1 and 43, Linehan discloses receiving a transaction request from a user at a server, issuing a challenge to the user, receiving a response from the user based upon said challenge, processing said response to verify an instrument/user, receiving a second request from said user at said server, said request including a credential and validating the credential to provide access to a transaction service (see col. 7, lines 20-37; fig. 2c; col. 1, lines 33-37).

Linehan does not expressly disclose assembling credentials for the transaction at said server, said credentials comprising at least on key, providing at least a portion of said assembled credentials

Art Unit: 3621

to said user, said second request including said portion of said assembled credentials provided to said user or validating said portion of said assembled credentials provided to said user with said key of said assembled credentials to provide access to a transaction service. Fox et al. disclose assembling credentials for the transaction at said server, said credentials comprising at least one key, providing at least a portion of said assembled credentials to said user (see col. 11, lines 1-27), said second request including said portion of said assembled credentials provided to said user or validating said portion of said assembled credentials provided to said user with said key of said assembled credentials to provide access to a transaction service (see col. 25, lines 11-35). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the method disclosed by Linehan to include the steps of assembling credentials for the transaction at said server, said credentials comprising at least one key, providing at least a portion of said assembled credentials to said user, said second request including said portion of said assembled credentials provided to said user or validating said portion of said assembled credentials provided to said user with said key of said assembled credentials to provide access to a transaction service. One of ordinary skill in the art would have been motivated to do this because it provides additional security by preventing unauthorized individuals from accessing the service; thus, preventing fraud.

Referring to claims 2,3,44 and 45, Linehan discloses the transaction is an electronic purchase transaction conducted using a digital wallet (see abstract, lines 1-4).

Referring to claim 4, Linehan discloses the instrument is a smart card (see col. 7, lines 21-23).

Referring to claim 46, Linehan discloses the method wherein the user conducts the transaction via a smart card (see col. 7, lines 21-23).

Conclusion

4. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- US Pub. No. 2003/009734 to Chaum et al. discloses a multi-purpose transaction card system that employs the Commit-Challenge-Response Protocol.

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jalatee Worjloh whose telephone number is 703-305-0057. The examiner can normally be reached on Mondays-Thursdays 8:30 - 7:00.

Art Unit: 3621

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on 703-305-9768. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306, 703-746-9443 for Non-Official/Draft.

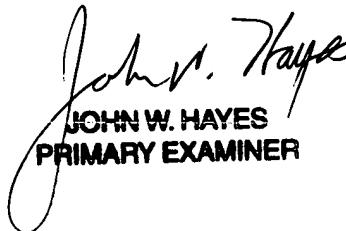
Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
PO Box 1450
Alexandria, VA 22313-1450

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington, V.A., Seventh floor receptionist.

October 7, 2003


JOHN W. HAYES
PRIMARY EXAMINER